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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,991	06/25/2003	Apurva F. Dalia	MSFT120702	5131

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EXAMINER	
ANYA, CHARLES E	

ART UNIT	PAPER NUMBER
2194	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,991	DALIA ET AL.	
	Examiner	Art Unit	
	Charles E. Anya	2194	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3/ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 6/25/03.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) 1-19 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-19 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-19 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9,11,12,13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The following terms lack antecedent basis:

i. "sail" on line 13 of claim 1.

For the purpose of this office action the Examiner would change "sail" to "said".

ii. "address book management system" on line 3 of claims 3,4,5,12 and 13; line 2 of claims 6,7 and 11.

For the purpose of this office action the Examiner would change "address book management system" to "the integrated address book clearinghouse".

iii. "the integrated address book clearinghouse system" on line 3 of claim 15.

For the purpose of this office action the Examiner would change "the integrated address book clearinghouse system" to "the integrated address book clearinghouse".

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1 - 9 are directed to application programming interface, which is software per se and therefore neither a process, machine, manufacture nor composition of matter. In contrast, a claimed computer-readable storage medium encoded with an application programming interface is a computer element with defined structural and function interrelationships between the application programming interface and the rest of the computer which permit the application programming interface's functionality to be realized, and is thus statutory. Accordingly, appropriate correction or amendment is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1,3,4,8-13,18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,835,089 to Skarbo et al. in view of U.S. Pat. No. 6,370,566 B2 to Discolo et al.

7. As to claim 1, Skarbo teaches a programming interface layer for an integrated address book clearinghouse that receives programming interface function calls for the integrated address book clearinghouse, the programming interface layer including address book management functions usable by any of a plurality of applications to manage the integrated address book clearinghouse (figure 2), the programming interface layer comprising: a plurality of executable address book management functions (Address Book Dynamic Link Library 110, Database Dynamic Link Library 112, Address Book Application Program Interface (API) 122, Address Book API 120 Col. 4 Ln. 27 – 52); a parameter processing module for processing function-specific parameters, including identity information for an address book ("...ISDN addresses..." Col. 5 Ln. 1 – 8, "...address book information..." Col. 5 Ln. 9 – 17, "...destination identifiers..." Col. 5 Ln. 26 – 35, "...wAppType parameter..." Col. 7 Ln. 20 – 24), for one of said plurality of address book management functions, wherein said function-specific parameters are encapsulated function call data envelope identified as associated with said one of said address book management functions (Col. 5 Ln. 1 – 63, Col. 6 Ln. 1 – 27, "...function call..." Col. 8 Ln. 56 – 65, "...iaDialNotify function call..." Col. 9 Ln. 1 – 25, "...iabSelectNotify function call..." Col. 9 Ln. 40 – 67, figure 6 Col. 10 Ln. 56 – 67).

Skarbo is silent with reference to a response generating module for generating a function-specific response from a said one of sail plurality of address book management functions, wherein said function-specific response is encapsulated in a response data envelope identified as associated with said one of said address book management functions and includes said identity information.

Discolo teaches a response generating module for generating a function-specific response from a said one of sail plurality of address book management functions, wherein said function-specific response is encapsulated in a response data envelope identified as associated with said one of said address book management functions and includes said identity information (figure 8 MAPI Col. 19 Ln. 34 – 49, Col. 20 Ln. 9 – 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Discolo and Skarbo because the teaching of Discolo would improve the system of Skarbo by providing a messaging application program interfaces (MAPI) that allows programmable access to features of an electronic mail messaging program (Discolo Col. 12 Ln. 42 – 62).

8. As to claim 3, Skarbo teaches the programming interface of Claim 1, wherein said one of said address book management function operates on a contact within an address book, corresponding to said identity information, in said integrated address book clearinghouse ("...ISDN addresses..." Col. 5 Ln. 1 – 8, "...address book information..." Col. 5 Ln. 9 – 17, "...destination identifiers..." Col. 5 Ln. 26 – 35, "...wAppType parameter..." Col. 7 Ln. 20 – 24).

9. As to claim 4, Skarbo teaches the programming interface of Claim 1, wherein said one of said address book management function operates on a group of contacts within an address book, corresponding to said identity information, in said integrated address book clearinghouse ("...ISDN addresses..." Col. 5 Ln. 1 – 8, "...address book information..." Col. 5 Ln. 9 – 17, "...destination identifiers..." Col. 5 Ln. 26 – 35, "...wAppType parameter..." Col. 7 Ln. 20 – 24).

10. As to claims 8-10,18 and 19, see the rejection of claim 1 above.

11. As to claim 11, Skarbo teaches the method of Claim 10, wherein said address book management function operates on an address book, corresponding to said identity information, in said integrated address book clearinghouse ("...ISDN addresses..." Col. 5 Ln. 1 – 8, "...address book information..." Col. 5 Ln. 9 – 17, "...destination identifiers..." Col. 5 Ln. 26 – 35, "...wAppType parameter..." Col. 7 Ln. 20 – 24).

12. As to claim 12, see the rejection of claim 3 above.

13. As to claim 13, Skarbo teaches the method of Claim 10, wherein said address book management function operates on a group of contacts within an address book, corresponding to said identity information, in said address book management system ("...ISDN addresses..." Col. 5 Ln. 1 – 8, "...address book information..." Col. 5 Ln. 9 –

17, "...destination identifiers..." Col. 5 Ln. 26 – 35, "...wAppType parameter..." Col. 7 Ln. 20 – 24).

14. Claims 2,5-7 and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,835,089 to Skarbo et al. in view of U.S. Pat. No. 6,370,566 B2 to Discolo et al. as applied to claim 1 above, and further in view of U.S. Pat. No. 7,092,945 B2 to Hall et al.

15. As to claim 2, Skarbo and Discolo are silent with reference to the programming interface of Claim 1, further comprising an identity verification module for verifying said identify information and any authentication information for said identity information prior to executing any of said address book management functions.

Hall teaches the programming interface of Claim 1, further comprising an identity verification module for verifying said identify information and any authentication information for said identity information prior to executing any of said address book management functions (figure 2 Col. 5 Ln. 26 – 65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Hall, Discolo and Skarbo because the teaching of Hall would improve the system of Discolo and Skarbo by a process for identifying a user of communication device which may be used to access a person database and providing the user with desired e-mail addresses, facsimile numbers, uniform resource locators (Hall Col. 2 Ln. 58 – 65).

16. As to claim 5, Hall teaches the programming interface of Claim 1, wherein said one of said address book management function operates on a permission setting for an owner of an address books corresponding to said identity information, in said integrated address book clearinghouse (Col. 3 Ln. 6 – 24).

17. As to claim 6, Hall teaches the programming interface of Claim 1, wherein said identity information is verified by an authentication server in said integrated address book clearinghouse (Col. 3 Ln. 6 – 24, Col. 4 Ln. 33 – 47).

18. As to claim 7, Hall teaches the programming interface of Claim 1, wherein said identity information is verified by a partner server in communication with said integrated address book clearinghouse (Col. 3 Ln. 6 – 24, Col. 4 Ln. 33 – 47).

19. As to claim 14, Hall teaches the method of Claim 10, further comprising obtaining authentication information for said identity information (Col. 3 Ln. 6 – 24, Col. 4 Ln. 33 – 47).

20. As to claim 15, Hall teaches the method of Claim 14, further comprising sending said identity information and said authentication information to a partner computing system accessible by the integrated address book clearinghouse (Col. 3 Ln. 6 – 24, Col. 4 Ln. 33 – 47).

21. As to claim 16, Hall teaches the method of Claim 14, further comprising encapsulating said identity information and authentication information in said function call data envelope (Col. 3 Ln. 6 – 24).

22. As to claim 17, Hall teaches the method of Claim 15, wherein said authentication information is obtained from a remote authentication service (Col. 3 Ln. 6 – 24, Col. 4 Ln. 33 – 47).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles E. Anya whose telephone number is (571) 272-3757. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Thomson can be reached on (571) 272-3718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Charles E Anya
Examiner
Art Unit 2194

cea.

WILLIAM THOMSON
SUPERVISORY PATENT EXAMINER